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Docket No. FJ-2003-046-US  
(MAS.018)

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### REMARKS

Entry of this Amendment is proper because it does not raise any new issues requiring further search by the Examiner, narrows the issues on appeal, and is believed to place the present application in condition for immediate allowance.

Claims 1-14 are all the claims presently pending in the application. No claims have been amended.

Claims 1-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Allam (U.S. Patent Publication No. 2004/0139400 A1) in view of Pruett (U.S. Patent No. 5,778,389).

These rejections are respectfully traversed in the following discussion.

#### **I. THE CLAIMED INVENTION**

The claimed invention is directed to a program for a method of transferring files that improves operability of file transfer in processing of multimedia files with a personal computer.

For example, independent claim 1 exemplarily defines a computer-readable medium tangibly embodying a program of recordable, computer-readable instructions executable by a digital processing apparatus to perform a method of transferring files, the method including, when a file stored in a first folder is selected to be stored into a second folder, comparing a filename of the selected file with a filename of each file already stored in the second folder. If the second folder contains no file having a filename same as the selected file, the method further includes storing the selected file into the second folder. If the second folder contains a file having a filename same as the selected file, the

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method further includes displaying thumbnail images and file information of the selected file and the file having the same filename together on a display device.

According to the present invention, if there is a file, in the target folder, having the same filename as a file selected to be transferred into the target folder, thumbnail images and file information of the selected file and the file having the same filename are displayed together on a display device. Thus, a decision whether or not to overwrite the file is promoted.

For example, in the case of a still image file, the still image in the folder is reduced and then displayed as its thumbnail image. Therefore, by comparing both of the thumbnail images, a decision whether or not to overwrite the file can be executed at a glance and operability of file transfer is improved (e.g., see specification at page 2, lines 20-28).

Somewhat similarly, in displaying thumbnail images and file information of two or more files together, the first frame of a movie included in a movie file can be displayed such that the contents of the file can be determined at a glance and operability of file transfer can be improved. Furthermore, by operating a thumbnail image (e.g., click operation), the movie can be played back such that the contents of the file become clearer and operability of file transfer is further improved (e.g., see specification at page 3, lines 4-8).

Moreover, according to the present invention, even for audio files, the contents of which cannot easily be determined visually, icon images that indicate they are audio files can be displayed. According to the claimed invention, by operating the icon images (e.g., click operation), the audio is played back. Thus, a decision whether or not to overwrite

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an audio file can easily be executed, and operability of file transfer is improved (e.g., see specification at page 3, lines 19-23).

## II. THE PRIOR ART REJECTION

Claims 1-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Allam in view of Pruett.

In the Response to Arguments of the present Office Action, the Examiner states that the "declaration filed on 9/5/2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Allam (USPA Pub. 2004/0139400) reference because of the following reasons:

- The proposed reply filed on 9/5/2006 has not been entered because it is unsigned.
- The declaration does not contain the invention disclosure statement correlating to the claims.
- The declaration does not contain explanation of the contents of the invention disclosure document."

Applicant respectfully traverses this rejection, for at least the following reasons.

1) First, Applicant notes that the Amendment filed on September 5, 2006 specifically noted that the un-executed declaration under 37 C.F.R. § 1.131 was being filed to expedite the Examiner's consideration of the application, and that the executed declaration would be filed upon receipt from the inventor (see Amendment under 37 C.F.R. § 1.111 filed on September 5, 2006, at page 11, lines 4-8).

Accordingly, the executed Declaration under 37 C.F.R. § 1.131 was filed in the USPTO via facsimile on November 14, 2006, as evidenced by the attached PTO facsimile

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filing receipt, and copies of the "Transaction History" and "Available Documents" obtained from the USPTO PAIR site.

As indicated on the PAIR site, Applicant notes that the present Office Action was entered on November 24, 2006, and mailed on November 27, 2006, which was after the filing of the executed Declaration under 37 C.F.R. § 1.131 on November 14, 2006.

Thus, Applicant respectfully submits that the Examiner properly should have entered and considered the executed Declaration, which was filed on November 14, 2006, prior to issuing the present Office Action.

Indeed, since the un-executed Declaration and the executed Declaration were identical, except for the inventors' signatures, Applicant respectfully submits that sufficient time clearly was available to enter and consider the executed Declaration prior to entering the Office Action on November 24, 2006, and subsequently mailing the same on November 27, 2006. Moreover, the Examiner's statements above with respect to the content of the unexecuted Declaration indicate that the Examiner had considered the unexecuted Declaration, although it was not entered.

2) Second, the Examiner alleges that the "declaration does not contain the invention disclosure statement correlating to the claims."

However, Applicant notes that the Declaration under 37 C.F.R. § 1.131 clearly includes a statement that the inventor is the sole inventor of the above-identified application (see Declaration under 37 C.F.R. § 1.131, at numbered paragraph (1)). Clearly, since Applicant is the sole inventor of the present application, the Applicant is the sole inventor of all of the claims of the present application.

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Moreover, Applicant's representative pointed out that **paragraph 5** of the Declaration clearly states that:

5) The contents of the enclosed "Invention Disclosure Documents" (Exhibit 1) have been incorporated into the specification of the present invention, upon which claims 1-14 are based.

Moreover, Applicant submits that all of the requirements for filing a Declaration under 37 C.F.R. § 1.131 have been met by the present Declaration (e.g., see 37 C.F.R. § 1.131; see also 37 C.F.R. § 1.68; see also M.P.E.P. § 715).

It is noted that 37 C.F.R. § 1.131 states that:

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e).

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

That is, Applicant must show invention of the subject matter of the rejected claims. Applicant submits that the Exhibits submitted with the Declaration show invention of the subject matter of the rejected claims.

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Applicant is not aware of a requirement that an invention disclosure statement that explicitly identifies the rejected claims must be made for the Declaration under 37 C.F.R. § 1.131 to be effective.

Should the Examiner consider this statement to be a requirement of a Declaration under 37 C.F.R. § 1.131, the Examiner is requested to identify the basis for this requirement in the applicable law, rules, or procedures.

3) Third, the Examiner alleges that the "declaration does not contain explanation of the contents of the invention disclosure document."

However, Applicant notes that a full English language translation of the Invention Disclosure Document was submitted as Exhibit 2, together with the Declaration.

Thus, it is unclear what explanation of the contents of the invention disclosure document that the Examiner considers to be missing from the Declaration.

For the foregoing reasons, Applicant submits that the Declaration under 37 C.F.R. § 1.131 filed on November 14, 2006 properly should have been entered by the Examiner.

Moreover, Applicant submits that the Allam reference should be removed as prior art, since Applicant has perfected the claim to foreign priority and properly filed a Declaration under 37 C.F.R. § 1.131 showing invention of the subject matter of the present application prior to the effective filing date of the Allam reference.

Applicant reiterates that the Allam reference is available as prior art only under § 102(e) as of the October 23, 2002 U.S. filing date of the parent Provisional Application from which Allam claims priority. On the other hand, the present application claims foreign priority from JP 2002-361998, which was filed on December 13, 2002. It is noted that the § 102(e) date of October 23, 2002 of Allam is one (1) month and twenty (20)

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days prior to the filing date of the present application's Japanese priority document on December 13, 2002.

Therefore, Allam should be removed as prior art under 35 U.S.C. § 102(e) because Applicant (1) perfected the claim to foreign priority based on JP 2002-361998, which was filed on December 13, 2002, by the filing a verified English translation thereof on September 5, 2006; and (2) filed the executed Declaration under 37 C.F.R. § 1.131 which properly swears behind the critical date (i.e., October 23, 2002) of Allam, by establishing invention of the subject matter of the present application before the Allam reference's effective § 102(e) prior art date of October 23, 2002.

Accompanying this Amendment is a re-submission of the executed Declaration under 37 C.F.R. § 1.131, including the PTO facsimile filing receipt, and copies of the "Transaction History" and "Available Documents" obtained from the USPTO PAIR site, for the Examiner's convenience.

Applicant submits that the Declaration properly swears behind the effective prior art date of the Allam reference by establishing a reduction to practice prior to the effective date of the Allam reference, or in the alternative, conception of the invention, coupled with due diligence from just before the effective date of the Allam reference up to the constructive reduction to practice of the present application by the filing of the JP 2002-361998 priority document.

For the foregoing reasons, Applicant reiterates that the Allam reference should be removed as prior art and the Examiner is requested to withdraw these rejections and to permit these claims to pass to immediate allowance.

Notwithstanding the above, Applicant respectfully submits that there are features of the claimed invention which clearly are not disclosed or suggested by Allam and

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Pruett, either individually or in combination. However, since Allam can be removed as prior art, thereby removing the present rejection, Applicant reserves the opportunity to traverse the alleged combination of these references, or the individual teachings of these references, at a later time.

For the foregoing reasons, Allam and Pruett, either individually or in combination, do not disclose or suggest all of the features of the claimed invention. Therefore, the Examiner is requested to reconsider and withdraw this rejection and to permit claims 1-14 to pass to immediate allowance.

### III. CONCLUSION

In view of the foregoing, Applicants submit that claims 1-14, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.



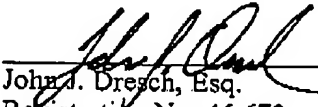
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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,


Date: January 26, 2007

  
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**CERTIFICATE OF TRANSMISSION**

I certify that I transmitted via facsimile to (571) 273-8300 the enclosed Request for Reconsideration under 37 C.F.R. § 1.116, and copies of the previously filed Declaration under 37 C.F.R. § 1.131 and Exhibits, and PTO PAIR information, to Examiner Sathyanaraya R. Pannala, Art Unit 2164, on January 26, 2007.

  
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